

REMARKS

Claim Status

Claims 1-13 are pending in the application and stand rejected. Claims 1-13 have been rejected under 35 U.S.C. § 103.

Rejections Under 35 U.S.C. § 103

Rejections of Claims 1-10 over Roberts et al.

Claims 1-10 are rejected under 35 U.S.C. § 103 as unpatentable over Roberts et al. (U.S. Patent 6,101,486). It is the Applicants' position that these rejections are improper and should be withdrawn. Specifically, the Office Action fails to make out a *prima facie* case of obviousness of Claim 1 based upon the Roberts et al. patent.

Firstly, Applicants point out that while the Roberts et al. patent purports to be directed to a system for use by customers, the users of the Roberts et al. system are not customers as that term is used in the present application and claims. Pages 4-5 of the present specification, for example, make clear that "customers" as that term is used in Claim 1 are purchases of goods for resale. Similarly, "consumers" as that term is used in the present application are the ultimate users of such goods. The Roberts et al. patent, by contrast is directed to a support system used by employees or consumers for the purchase of services (not goods). Although the Roberts et al. specification does use the term "customer," this term does not have the same meaning as that given it by applicant in the present specification. As the applicant has chosen to be his own lexicographer with respect to terms such as "customer," "consumer," and "goods," these definitions must be used for examination of the claims. Similarly, the term "customer" as it is used in the Roberts et al. patent, must be construed in the context of its specification. In the Roberts et al. patent, the term "customer" has a meaning akin to the term "consumer" in the present application.

While certain general aspects of the system described in the Roberts et al. patent and the system claimed in Claim 1 of the present application are similar, the description given in the Roberts et al. application does not render Claim 1 obvious. As noted, the Office Action does not show any motivation in the Roberts et al. patent to modify its teachings to apply to customers purchasing goods for re-sale to consumers. The investigation of services by consumers of such services as described in the Roberts et al. patent is very different from the system of Claim 1.

It is essential to consider all elements of the claimed invention and to compare them with the teachings of the prior art as a whole; it is impermissible to compare the prior art with what the viewer interprets the "gist" of the invention to be. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888 (Fed. Cir. 1984); Jones v. Hardy, 727 F.2d 1524, 1527-28 (Fed. Cir. 1984) ("Reducing a claimed invention to an 'idea' is error."). In re Fine, 837 F.2d 1071 (Fed. Cir. 1988); In re Evanega,

829 F.2d 1110 (Fed. Cir. 1987). While the Examiner has not expressly done this in the instant Office Action, if the specific differences between customers and consumers, goods and services are not taken into account, this is in effect the result.

The present specification contains extensive teaching regarding the particular considerations that are applicable to the purchase of goods by customers, and considerations regarding customizing product information to a given customer. The Office Action does not show how the Roberts et al. patent which deals with services and the ultimate users of those services provides these missing features of Claim 1. Customizing information regarding goods which a purchaser will ultimately re-sell to others is very different than direct marketing to consumers of services. In the system of Claim 1, the user (i.e. the customer) will be purchasing on behalf of others, not himself or herself. These differences are substantial and cannot be overlooked. Therefore, because the Roberts et al. patent does not teach or suggest these features of Claim 1, and because the Office Action does not provide any suggestion or motivation to modify the teachings of Roberts et al. to arrive at such features, the Roberts et al. patent cannot render Claim 1 obvious.

Claims 2-10 depend on Claim 1 and the analysis given above with respect to Claim 1 is equally applicable to Claims 2-10. Therefore, Claims 2-10 are not obvious over the Roberts et al. patent for the same reasons given above with respect to Claim 1. The Examiner is, therefore, respectfully requested to withdraw the rejections of Claims 1-10 under 35 U.S.C. § 103 and to allow the claims.

Rejection of Claims 11-13 over Roberts et al.

Claims 11-13 have been rejected under 35 U.S.C. § 103 as unpatentable over the Roberts et al. patent. The Office Action has not made out a proper *prima facie* case of obviousness with respect to Claims 11-13. The analysis applied in the Office Action with respect to Claims 11-13 is substantially similar to that applied with respect to Claims 1-10. Therefore, the explanation given above regarding the differences between the system described in the Roberts et al. patent and the system of Claims 1-10 is equally applicable to Claims 11-13. For example, the Office Action does not show how the Roberts et al. patent shows the claimed system for providing algorithms to associate product information (as opposed to services) to customers (as opposed to consumers).

SUMMARY

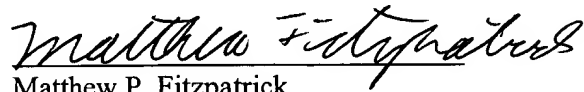
All of the relevant rejections in the Office Action have been discussed.

In light of the discussions contained herein, Applicants respectfully request reconsideration of the rejections and their withdrawal, and that all of the claims be allowed.

Issuance of a Notice of Allowance at an early date is respectfully requested.

Respectfully submitted,

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